

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT FALCO

Appeal No. 2002-2089
Application No. 09/482,237

ON BRIEF

Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-5 and 7-29 which are all of the claims remaining in the application.

The subject matter on appeal relates to a hearing protector earplug comprising a body having a stem channel formed therein and a stem member disposed within the stem channel. According to claim 1, the stem member comprises a material having a glass transition temperature range between about 50 to about 100 degrees Fahrenheit. Pursuant to claim 19, the stem member comprises a material such

that insertion of the earplug in an ear of a user results in the stiffness of the stem member decreasing such that at least a portion of the stem member inserted into the ear becomes less stiff upon being inserted and positioned within the ear. As a result of the above discussed properties, the stem member permits the ear plug to be stiff for insertion into the ear while thereafter becoming less stiff so that any excess pressure caused by the insertion is relieved. This appealed subject matter is adequately illustrated by independent claims 1 and 19 which read as follows:

1. A hearing protector earplug, comprising:

a body having an insertion end and an opposing second end, the body including a stem channel formed therein; and

a stem member disposed within the stem channel, the stem member comprising a material having a glass transition temperature range between about 50 to about 100 degrees Fahrenheit.

19. A hearing protector earplug comprising:

a body having an insertion end and an opposing second end, the body including a stem channel formed therein; and

a stem member disposed within the stem channel, the stem member comprising a material such that insertion of the earplug in an ear of a user results in the stiffness of the stem member decreasing such that at least the portion of the stem member inserted into the ear becomes less stiff upon being inserted and positioned within the ear.

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The references set forth below are relied upon by the Examiner as evidence of obviousness:

Brueggemann et al. (Brueggemann)	4,237,176	Dec. 2, 1980
Falco	4,867,149	Sep. 19, 1989
Leonard	4,936,411	June 26, 1990
Esler et al. (Esler)	Des. 369,655	May 7, 1996
Falco et al. (Falco)	5,809,574	Sep. 22, 1998
Leight	5,811,742	Sep. 22, 1998
Leight et al. (Leight)	6,006,857	Dec. 28, 1999

Claims 1, 3-5, 7-9, 17-19, 22-25, 27 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Falco '574 in view of Brueggemann, and the remaining claims on appeal stand correspondingly rejected over these references in various combinations with the other prior art listed above.

We refer to the brief and reply brief and to the answer for a complete exposition of the contrary viewpoints expressed by the Appellant and the Examiner concerning the above noted rejections.

OPINION

The rejections advanced by the Examiner in this appeal cannot be sustained.

As correctly argued by the Appellant in the brief and reply brief, the Falco '574 and Brueggemann references contained no teaching or suggestion of forming the "stem member" of Falco '574 from a material of the type disclosed by Brueggemann (i.e., a

material having a glass transition temperature within the range defined by appealed claim 1). On page 5 of the answer, the Examiner expresses his opposing viewpoint in the following manner:

It would have been obvious to a person with ordinary skill in the art to formed the Falco et al. stem member from the material disclosed by Brueggemann et al. because the material have the property of having a glass transition temperature between a range of ambient temperature and the internal human temperature. The property is useful to maintain the stem stiff during the insertion of the earplug and then once inserted the stem would decrease it stiffness to make the earplug comfortable to the user.

Manifestly, the Examiner's above quoted rationale is defective. Neither of the references under consideration contains any disclosure relating to a property involving glass transition temperatures "between a range of ambient temperature and the internal human temperature" (id.) or a property which "is useful to maintain the stem stiff during the insertion of the earplug and then once inserted the stem would decrease in stiffness to make the earplug comfortable to the user" (id.). It is only the Appellant's specification which contains disclosure of such a property. It is apparent therefore, that the Examiner's aforequoted conclusion of obviousness is based upon impermissible hindsight. See W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540,

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1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied,
469 U.S. 851 (1984).

As additional support for his obviousness conclusion, the Examiner urges that "there is enough motivation suggested by the cited [Falco '574 and Brueggemann] references for a person with ordinary skill in the art to combine both references and end up with the claimed subject matter because both references are directed to solve the same problem, which is to form a device that works as a sound dampening." (answer, page 13). We cannot agree. According to the disclosure of Falco '574, patentee's stem member performs the function of attaching a hearing protector to a head band frame. While the hearing protector performs a sound dampening function, the Examiner points to nothing in this reference which associates a sound dampening function with patentee's stem member. Plainly, the Examiner's rationale once again is based on impermissible hindsight derived from the Appellant's own disclosure. W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d at 1553, 220 USPQ at 312-13.

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For the above stated reasons, we cannot sustain the Examiner's § 103 rejection of claims 1, 3-5, 7-9, 17-19, 22-25, 27 and 29 as being unpatentable over Falco '574 in view of Brueggemann. Since the other applied prior art has not been relied upon by the Examiner to cure the previously discussed deficiencies, the remaining rejections advanced on this appeal also cannot be sustained.

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The decision of the Examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

TAW/jrg

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CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002